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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,870	12/12/2003	William F. Leek	SIMP-51002US0	1550
28554	7590	05/04/2006	EXAMINER	
VIERRA MAGEN MARCUS & DENIRO LLP 575 MARKET STREET SUITE 2500 SAN FRANCISCO, CA 94105			HORTON, YVONNE MICHELE	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/734,870	Applicant(s) LEEK ET AL.	
	Examiner Yvonne M. Horton	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-37 is/are allowed.
- 6) ☒ Claim(s) 1-6,9,10,12,13,16 and 19-23 is/are rejected.
- 7) ☒ Claim(s) 7,8,11,14,15,17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/04 & 6/16/05</u> . | 6) <input type="checkbox"/> Other: _____ |

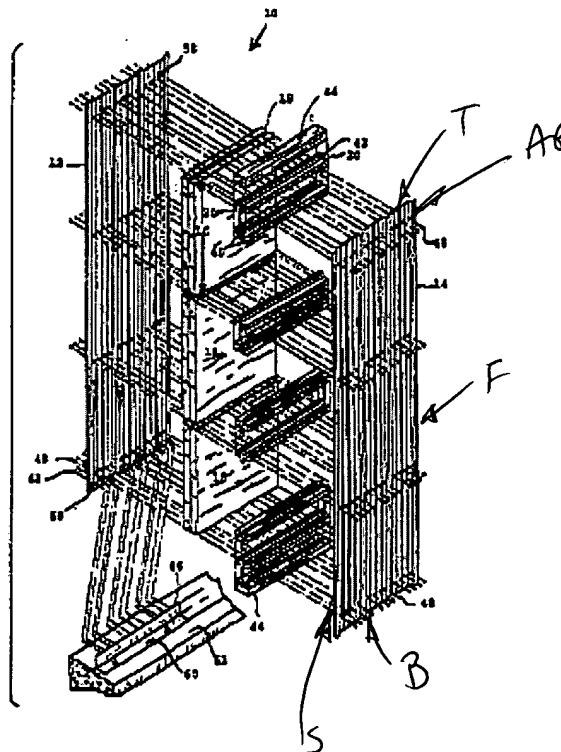
DETAILED ACTION***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,10,12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,390,466 to JOHNSON et al. JOHNSON et al. discloses the use of a shearwall (10) including a central diaphragm having a top (T) and bottom (B) edge and first (F) and second (S) ends defining the height and width of the diaphragm, and a corrugated section (12,14) extending between the top (T), bottom (B), first (F) and second (S) edges/ends, see below. Regarding claim 2, the shearwall also includes a



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sill plate (60) affixed to the bottom edge (B). In reference to claims 10,12 and 13, the corrugations include at least two and the corrugated section further includes apertures (AP).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-6,16 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,390,466 to JOHNSON et al. in view of US Patent #6,560,940 to MUELLER. In reference to claim 16, JOHNSON et al. discloses the use of a shearwall (10) including a central diaphragm having a top (T) and bottom (B) edge and first (F) and second (S) ends defining the height and width of the diaphragm, and a corrugated section (12,14) extending between the top (T), bottom (B), first (F) and second (S) edges/ends. JOHNSON et al. discloses the basic claimed shearwall except for the use of side chords, and the specifics of the materials used to make the

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shearwall. Regarding claim 3 and further regarding claim 16, MUELLER teaches the use of side chords (110). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the shearwall of JOHNSON et al. with the side chords of MUELLER in order to further strengthen the shearwall. Side chords give added strength and resistance to buckling. In reference to claim 5, although silent, it would have been obvious to one having ordinary skill in the art the JOHNSON et al., as modified by MUELLER, would allow for the sill member (60) of JOHNSON et al. to be sized to accommodate the side chords of MUELLER. Regarding claims 6 and 20, neither JOHNSON et al. nor MUELLER discloses the use of 7-gauge steel. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known gauge steel suitable for the use intended as an obvious matter of design choice. In reference to claims 19 and 21-23, the thickness of the sill plate and the height, width and depth of the shearwall, are all matters obvious to one having ordinary skill in the art to select according to the use intended as design choice. For instance, larger sized shear walls may be employed in larger building settings such as factories; whereas smaller shearwalls may be used in residential settings.

Allowable Subject Matter

Claims 7,8,9,11,14,15,17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24-37 are allowed.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yvonne M. Horton
Art Unit 3635
5/1/06